

dismissed. The examiner cited *In re McLaughlin* as support for a conclusion of obviousness on hindsight "so long as [the hindsight] takes into account only the knowledge which was within the level of ordinary skill at the time the claimed invention was made" The examiner's reliance on *McLaughlin* is misplaced.

The examiner has taken the incredible position that there are two types of hindsight in patent cases, one permissible, the other impermissible. A careful reading of *McLaughlin* shows that this is just not true. *In re McLaughlin* is a seminal case providing guidance on combining references and does not establish "permissible hindsight." The facts of *McLaughlin* relate to a patent application for an improved railroad boxcar loading construction. In rejecting the claims as obvious, the examiner in *McLaughlin* cited references also relating to boxcars. The applicant, *McLaughlin*, argued that the references were improperly combined. The court held that the test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art. In other words, a 103(a) rejection may be properly based on a combination of references and what is known in the art. The phrase "hindsight reasoning" appears in the case, but the case does not give license to examiners to use hindsight as a basis for rendering a claim obvious. It is key in the analysis of *McLaughlin* that all of the prior art related to boxcars.

One cannot use hindsight reconstruction to pick and choose among isolated, unrelated, disclosures in the prior art to depreciate the claimed invention. See *W.L. Gore & Associates v. Garlock, Inc.* 721 F. 2d 1540, 1553, 220 USPQ (BNA) 303, 313 (Fed. Cir. 1983), and *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ 2d (BNA) 1614. Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) and there is a requirement for a showing of the teaching or motivation to combine prior art references. See

C.R. Bard, Inc. v. M# Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d (BNA) 1225, 1232 (Fed. Cir. 1998). Nearly 30 years after *McLaughlin*, the rule of law still stands. There is no "permissible hindsight."

The examiner can satisfy the burden of obviousness in light of a combination of references "only by showing some objective teaching [leading to the combination.]" See *In re Fine* 837 F.2d 1071, 1075, 5 USPQ 2d (BNA) 1596, 1600 (Fed. Cir. 1988). Combining prior art references without evidence of a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability. See *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ (BNA) 543, 547 (Fed. Cir. 1985).

The examiner had to go as far afield as to gather handbag patents to piece together some of Applicant's invention. The examiner has not found references for every element of Applicant's invention and has not described what knowledge, existing at the time of invention, would have led one of ordinary skill to practice Applicant's invention. The Applicant respectfully requests that the examiner consider these remarks during the prosecution of the Continuation Application submitted herewith.

Respectfully submitted,


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September 26, 2001
Atty. Docket No. P1299CIP/CON
CH01/12179748.1